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10/049,419	02/12/2002	Takanari Tominaga	1422-0514P	1153

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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FONDA, KATHLEEN KAHLER

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 08/12/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/049,419

Applicant(s)

TOMINAGA ET AL.

Examiner

Kathleen Kahler Fonda, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Any rejection made in a prior Office action and not expressly repeated herein is withdrawn in view of Applicant's arguments and/or amendments.

Applicant will note that the cover sheet for this Office action indicates that not all priority documents have been received from the International Bureau. Although Japanese application 2000-69223 03/13/2000 is in the file, Japanese application 11-234262 08/20/1999 is not. The Examiner is attempting to obtain a copy of the missing document from the International Bureau.

Claims 29-32, 45, and 46 are objected to under 37 CFR 1.75 as being substantial duplicates of claim 28. When two or more claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The claims are substantial duplicates because they all require the same ingredient in the same amount. The intended use does not serve to distinguish the claims.

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The Examiner notes that this is essentially the same ground for objection applied to claims 3-5, 7, 8, and 10 in the previous Office action. Applicant has correctly stated that the objection in the prior Office action is now moot due to cancellation of claims 3-5, 7, 8, and 10, but Applicant has presented no argument as to why it should not apply to the newly presented claims.

Each of claims 28-32 and 45-48 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/148,486, now published as US 2002/0039670. This is essentially the same ground of rejection as applied to now-canceled claims 22 and 24-27 in the Office action of 03-21-03. Although the conflicting claims are not identical in that copending claim 1 recites a sulfated monosaccharide and a salt of fucoidan not mentioned in the instant claims, they are not patentably distinct from each other because both the pending claims and the copending claims recite cosmetics comprising fucoidan or a degradation product thereof. Statements of intended use do not distinguish the claims. Choosing an amount within the wide ranges of claims 47 and 48 would have been obvious because it is within the scope of general knowledge of a

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person skilled in the cosmetic arts to provide ingredients in such ranges. No criticality associated with the amounts of the claims is evident.

The Examiner notes that Applicant states in the second paragraph on page 9 of the Remarks of 07-24-03 that the provisional obviousness-type double patenting rejections are traversed. However, no substantive traversal has been presented, except to note that claims have been canceled. In the sentence bridging page 9-10 of the Remarks of 07-24-03, Applicant requests that the rejection be held in abeyance in accordance with MPEP 804. MPEP does not allow the Applicant to wait until some later time to offer a substantive traversal. Applicant is required to respond to every ground of rejection raised by the Examiner, although submission of documents such as a terminal disclaimer may sometimes be deferred. Applicant is advised that if Applicant presents a submission in response to this Office action, it will be considered non-responsive unless it includes either a statement that an appropriate terminal disclaimer will be submitted if the copending application issues first with a claim which is substantially the same as copending claim 1, or an argument substantively traversing the rejection.

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Claims 33-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 33-44 are indefinite because they fail to recite any particular and distinct steps of the claimed methods. The Examiner notes that claim 33 recites "administering" the fucoidan, but fails to recite any host to receive the administration. Claim 39 merely states that the fucoidan "is used as an effective ingredient" without providing any positive steps at all.

Claims 28-52 are rejected under 35 U.S.C. 102(e) as being anticipated by UMEDA *et al.* (A). UMEDA teaches a tea preparation comprising fucoidan derived from *Kjellmaniella crassifolia* in Example 6. UMEDA also teaches that the tea was administered orally to twenty panelists. The amounts recited in the instant claims are within those set forth in Example 6. With regard to claims 49-52, which require a "subject in need" of "treating or preventing a disease requiring regulation of cytokine production, a disease requiring nitrogen monoxide production, or an allergic disease," the Examiner notes that the preventive aspect of the claims reads on administration to well

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persons, as was apparently the case of the panelists of UMEDA. Furthermore, with regard to the fact that the claims recite a cosmetic, the Examiner notes that at page 36 line 10 of the specification, Applicant states that the "cosmetic of the instant invention is effective for oral administration." Thus, the tea of UMEDA is considered to be a cosmetic within the scope of the claims.

Whether or not UMEDA mentions "treating or preventing a disease requiring regulation of cytokine production, a disease requiring nitrogen monoxide production, or an allergic disease" is not relevant to the issue at hand. In the context of the composition claims, the recitation merely states an intended use, and is without patentable weight. As for the method claims, in the context of an anticipation rejection, the Federal Circuit stated, "Where, as here, the result is a necessary consequence of what was deliberately intended, it is of no import that the article's authors did not appreciate the results." Mehl/Biophile Int'l Corp. v. Milgraum, 52 USPQ2d 1303, 1307 (Fed. Cir. 1999). Thus, because UMEDA deliberately intended the disclosed administration within the scope of the claims, and because the necessary result was "preventing a disease requiring regulation of cytokine production, a disease requiring nitrogen monoxide production, or an allergic disease,"

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the instant claims are anticipated regardless of whether or not UMEDA appreciated that result.

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The number of




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the fax machine for official papers in Technology Center 1600 is (703) 308-4556. Any document submitted by facsimile transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

INTERNET INFORMATION: Secure and confidential access to patent application status information is now available; see <http://www.uspto.gov/ebc/index.html> for more information. Also, <http://www.uspto.gov/web/offices/ac/comp/fin/clonedefault.htm> may be used to pay patent maintenance fees, pay non-filing application fees, and maintain USPTO deposit accounts.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached Monday through Friday from 7:30 a.m. until 4:00 p.m. If the Examiner cannot be reached, questions may be addressed to Supervisory Patent Examiner James O. Wilson at (703) 308-4624. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.

  
Kathleen Kahler Fonda, Ph.D., J.D.  
Primary Examiner  
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